

Remarks

As an initial matter, Applicant did not receive an initialed copy of the Information Disclosure Statement (IDS) form that was filed on May 18, 2005. Applicant respectfully requests the Examiner to consider each of the references cited in this IDS and to provide the Applicant with the initialed copy of the IDS form in the next correspondence.

After entry of the subject Amendment, Claims 1-5, 7-13, 16-19, 31-33, 35, 37, and 48-55 will remain in the application with Claims 1 and 31 being in independent form. Claims 1, 9, 16, and 31 are being amended and claims 6, 14-15, 34, and 38-39 are currently being cancelled. Claims 2-5, 7-8, 10-13, 17-19, 32-33, 35, 37, and 48-55 remain unchanged and claims 20-30, 36, and 40-47 were previously cancelled.

Claims 6, 31-35, 37-39, and 48-55 stand rejected under 35 U.S.C. §112 as being indefinite. Claims 6 and 34 have been cancelled and claim 31 has been amended as suggested by the Examiner. Accordingly, the §112 rejection is believed overcome.

Claims 1-4, 6-16, 18 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pradel (US 6,076,794). Claims 17, 31, 32, 34, 35, 37-39 and 48-55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pradel. Claim 5 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pradel in view of Tondato.

The independent claims (Claims 1 and 31) have been amended to overcome these rejections. In particular, each of these independent claims now require that the support structure include a first cup defining a cavity and an inner surface with the first portion of the insulator being at least partially disposed within the cavity. Also, the first portion of the insulator is configured to be contiguous with the inner surface. In other words, the first portion abuts the inner surface. Further, the support structure includes a flange uniformly positioned relative to the ledge. As specifically set forth in claim 1, the first portion of the insulator also defines an exterior surface complementary in configuration with the inner surface of the first cup. As specifically set forth in claim 31, the relative positioning of the flange positions the ledge between the flange and the plate.

Support for the amendments to claims 1 and 31 can be found in the application as originally filed at paragraph 0019 and at Figures 1 and 4-6. The Examiner is reminded of

MPEP section 2163.06, which states in part "...information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." Accordingly, no new matter is being introduced.

Turning to the prior art currently relied on by the Examiner, the Pradel reference does not disclose, teach, or suggest the structure of the mounting assembly as now claimed in independent claims 1 and 31. Specifically, Pradel discloses a suspension system having a support structure 4, 15, a piston rod 3, and a plate 11 mounted to the piston rod 3. A pair of insulators 8, 9 are disposed about the piston rod 3 and the support structure 4, 15. Although the support structure 4, 15 of Pradel includes a pair of cups, this support structure 4, 15 is quite different from the support structure of the subject invention as now claimed.

The cup 4 of the support structure 4, 15 of Pradel requires numerous indentations, one of which is shown next to the leader line of reference numeral 9 in Figure 1, that presumably prevent rotation (see Col. 3, lines 50-64). This type of arrangement of the cup 4 in Pradel will alter the resistance characteristics of the insulator 9. The subject invention, as claimed in claim 1, avoids this pitfall by having an insulator with an exterior surface that is complementary in configuration with an inner surface of the cup and contiguous with the inner surface. Further, claim 1 requires that the flange of the cup be uniformly positioned relative to the ledge of the insulator. Certainly, the insulator 9 of Pradel is NOT complementary in configuration or contiguous with the cup 4. In addition, the flange of the cup 4 of Pradel is NOT uniformly positioned relative to the ledge of the insulator 9.

There is also no suggestion, teaching, or motivation to modify the cup 4 to have the specific configuration as claimed in independent claim 1. The cup 4 of Pradel is specifically and deliberately configured in this manner and any reconstruction of the cup 4 to conform this cup 4 to the claimed invention would be an improper use of hindsight and would defeat the defined purpose of the cup 4. It is well recognized that a prior art design cannot be modified in such a manner as to make this design unsatisfactory for its intended purpose. The principle operation of the design in Pradel can also not be changed. One intended purpose and principle operation of the cup 4 in Pradel is the anti-rotation, which is accomplished through the use of the indentations. Applicant contends that there is no

suggestion or motivation to modify Pradel since any modification of the cup 4 in light of the claimed invention would change the principle operation of the cup 4 and would cause the cup 4 to be unsatisfactory for its intended purpose.

In light of the amendments to claim 1 and the arguments set forth above, independent claim 1 is believed allowable. Claims 2-5, 7-13, and 16-19 are also believed allowable as these claims depend from the unique features of claim 1.

As for independent claim 31, the insulator is also configured to be contiguous with the inner surface of the cup. Further, the flange is also uniformly positioned relative to the ledge for positioning the ledge between the flange and the plate. The insulator 9 of Pradel is NOT contiguous with the cup 4 and the flange of the cup 4 is NOT uniformly positioned relative to the ledge to dispose the ledge between the flange and plate. As discussed above, in addition to not disclosing the claimed invention, there is likewise no teaching, suggestion, or motivation to modify the cup 4 of Pradel to have the configuration of the cup as claimed in independent claim 31.

Claim 31 also requires that the insulator abut the plate, a jounce bumper be mounted to the plate on an opposite side of the insulator, and that the plate have a width at least equal to the maximum widths of the insulator and the jounce bumper. The Examiner has formulated an obviousness rejection of this limitation that appears to mischaracterize the claimed limitation (see the last sentence beginning on Page 7). The Examiner focuses on the orientation of the jounce bumper and insulator as opposed to the fact that these parts are mounted to the same plate. In particular, the Examiner states "Pradel's assembly comprises said jounce bumper being mounted to said plate 11 on a same side of said insulator...". The jounce bumper in Pradel, however, is mounted to plate 21 and the insulator is mounted to a different plate, which is plate 11. As such, the Examiner's statement does not make much sense except to point out that the jounce bumper and insulator 9 both face downward. In any event, the jounce bumper of Pradel is NOT mounted to an opposing side of the plate that secures the insulator as required by independent claim 31.

Further, there is absolutely no teaching, suggestion, or motivation to modify Pradel in such a manner. The Examiner contends that it would have been obvious "to have

arranged the plate, the insulator and the jounce bumper as claimed, since it has been held that rearranging parts of an invention involves only routine skill in the art". Although the Examiner did not specifically state what is meant by "rearranging parts", Applicant respectfully disagrees with this contention. In order to sustain a rejection of claim 31 using Pradel, the Examiner would need to completely and improperly redesign the assembly of Pradel using only hindsight as the Examiner's guide. As is well settled, a whole sale restructuring of the prior art to find a claimed invention is not proper. Even taking into consideration the improper rearranging of the plate 11, insulator 9 and jounce bumper of Pradel, the claimed features of the invention would still not be met. In particular, the first portion of the insulator 9 would NOT be contiguous with the cup 4 and the flange would NOT be uniformly positioned relative to the ledge as required by impendent claim 31.

In light of the amendments and the arguments set forth above, claim 31 is believed allowable. Claims 32-33, 35, 37, and 48-55 are also believed allowable as these claims depend from the unique features of claim 31.

The remaining references cited but not applied to the claims have been considered. Since the Examiner has apparently considered these references as less pertinent than the above listed references, further discussion of the non-applied references, at this time, is considered unnecessary. However, it is respectfully submitted that the claims in the subject patent application patentably define over all references of record either independently or in combination.

The Commissioner is authorized to charge our Deposit Account No. 08-2789 for any additional fees or credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.



Date: October 28, 2005

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CERTIFICATE OF EXPRESS MAILING

I hereby certify that the attached **Amendment, Two-Month Extension of Time check in amount of \$450.00, and return post card** are being deposited with the United States Postal Service as Express Mail, EV 695 473 883 US Label No. postage prepaid, in an envelope addressed to **Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450**, on **October 28, 2005**.



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